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09/558,945	04/26/2000	Jonathan Kepecs	18477-000510US	3005

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/558,945

Applicant(s)

KEPECS, JONATHAN

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 36-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 28-35 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

1. This communication is in response to amendment filed 6/9/03.

#### *Response to Amendment*

2. As per applicant's response to restriction of inventions, Group II claims 28-35 have been withdrawn from consideration. Group I claims 1-27 and 36-45 remain under prosecution and have been examined.

#### *Claim Objections*

3. Claims 1-27 and 36-45 are objected to because of the following informalities:

Claim 1, in lines 4-5 recites "an identified consumer". For proper antecedent basis it should read "said identified consumer".

Dependent claims 1-27 and 36-45 also inherit this deficiency.

Appropriate correction is required.

4. Claim 18 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 17. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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5. claim 40 is missing a period at the end of claim recitation.

***Double Patenting***

6. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6-8 of U.S. Patent No. 6,389,401. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one ordinary skill in the art to modify the invention of claim 1 of '401 patent in such as way that the "granting" step is performed as per claim 1 of the instant application (i.e. where the discount is granted to the identified consumer upon purchase of the item being promoted prior to the withdrawing step). Motivation for such improvement is that the selected promotion will be received by the consumer any time a purchase of the item is made by the identified consumer before the promotion is withdrawn (i.e. special offer expires, such as in the case of a consumer receiving a "rain check" wherein the consumer is identified by name, address and phone number etc. and the consumer receives the promotional price if a purchase of the selected item is made prior to a predetermined expiration of the rain check).

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7. Claims 2-4 are broadly covered by term "discount or special price" as are customary and well known methods of offering promotional discounts.

8. claim 5-7 recite customary steps of promoting items. For example, direct mail and posting notice of discounts and accessing promotions from kiosks via a customer loyalty cards are well known methods of promoting items. (also refer to claims 6-8 of the reference patent).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 9, 10, 19, 20, 23-26, 37, and 38-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. claims 37-44 are rejected as reciting the claimed subject matter which is vague, unclear and not clearly relating to the parent claim 1.

As an example, Claim 37 recites "a list of maximum possible discounts". However, the "withdrawing", "granting" and "holding"

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steps only require "discount or special price" included in the "promoting" step (see claim 1). Therefore, in claim 37, the limitation "a list of maximum possible discounts" is rendered non functional.

Claim 38 is recites "boundaries on correct behavior of an inverted promotion system as described in claim 1". Claim 1 is a method claim and therefore, this limitation fails to clearly point out the subject of claim.

Claim 38 and 39 depend on claim 37 and therefore are rendered unclear as explained above.

Claim 44 fails to further limit any limitation of method claim. It recites that the discount is promoted with additional information other than discount or (special) prices. However, the method steps are performed independent of this additional factual information.

No patentable weight is afforded to limitation "additional factual information other than discounts or prices". Claim 44, therefore is analyzed as claim 1.

11. Claims 9, 10, 19, 20 and 38-43 recite limitation "said inverted promotion of said item" at lines 5 of each of claims 9, 10 and lines 4-5 of each of claims 19 and 20. There is insufficient antecedent basis for this limitation in the claims.

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Claims 23-26 each recite limitation "wherein acceptance of said second selected item" in lines 2-3. There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-8, 11-18, 21-22, 27 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kremer, "Mail Order Selling Made Easier", Ad-Lib Publications, 1991, pp.75-79 and further in view of Scroggie et al (US Pat. 6,185,541).

Regarding claim 1, Kremer teaches a promotional discounts on items for sale to consumers, comprising:

Promoting a selected item with a discount.. (..first edition copy of the MOST EXCITING BOOK..., p. 77, ..THE TACTICAL EDGE. The book is offered at \$29..95, ...\$5 off the scheduled retail price of \$34.95...p. 79);

withdrawing said ..special price.. (the pre-publication offer is withdrawn after a deadline or offer expiration date of November 15, 1985..p. 79);

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granting said discount upon purchase of the item by the (identified) consumer prior to the withdrawing step (as recited on p. 79, the consumer is granted the discount of \$5 savings if he/she purchases the book before November 15, 1985);

holding the withdrawing step in abeyance upon the acknowledgment of the promoting step by the consumer (the publisher reserves the book for a consumer, if the consumer responds to the promotion by reserving the book..p. 79).

Kremer identifies the consumer by a group such as law enforcement professionals, Kremer thus identifies the consumer only his/her address. However, identifying a consumer by a unique identifier is well known in promotional methods as exemplified by the Scroggie reference (see abstract and Col. 4 L 42-59) . For example, retailers identify loyal customers by an unique identification in order to track their spending habits and develop the consumers purchase history. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement unique identification for each consumer by an unique id instead of addressing a whole group (such as consumer with certain profession) because providing unique identification to a consumer would provide more effective and focused incentive or promotion.

Claim 3: discount or special price comprises a reduction in price (refer to claim 1 analysis).

Claims 2, 4 : Kremer fails to teach that discount or special price comprises a free sample (claim 2) or points that can be accumulated (claim 4).



Official notice is taken that offering a free sample and providing points that can be accumulated is old and well known business practice in product sales and marketing. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use these features in the Kremer method because it would appeal a wider spectrum of consumers that it would provide promotions more suitable to consumers and/or products of different characteristics.

Claim 5: direct mail transmission to the identified consumer.. (Kremer, p. 75).

Claims 6-8: Kremer fails to disclose posting a notice of discount of the selected item on a network accessible from a kiosk at a location selling the item and acknowledgement comprises recording a visit. However, Scroggie, in the same field of endeavor, discloses a method of distributing discounts via a computer network to identified consumers wherein the discounts are accessible from a kiosk at store locations (see abstract and fig. 13, Summary of Invention and Background of Invention). Scroggie also teaches application of a loyalty card and posting of a notice of discount for the selected item as claimed.

It would have been obvious to one of ordinary skill in the art of promotion and marketing to implement the Kremer method of distributing promotions on the Internet using world wide web as disclosed by Scroggie because implementation of the method of extending promotional discounts on the Internet (e-mail transmission, web-page, network accessible from a kiosk etc.) would provide customary benefits of wider reach

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of potential consumers, easy access of the promotion to the consumers and economy offered by electronic distribution of the promotions.

Claims 11-12. refer to claim 7 analysis in reference to store loyalty card.

Claim 13-16 are analyzed per claims 2-5 respectively.

Claims 17-18 are duplicate claims and analyzed per claim 6 analysis.

Claim 21: promoting a second selected item with a discount ..to said identified consumer is interpreted as being inherent to Kremer since a plurality of books may be offered at discount to the selected consumer.

Claim 22: Kremer teaches this limitation inherently as follows:

Once the consumer accepts the first offer to purchase the first book, the publisher sends another such offer to the consumer because the publisher recognizes that the consumer is more likely to purchase a second book based on the past purchase.

Claim 27: in view of the fact that use of credit and debit cards to carry out purchase transaction is extremely well known, this feature is inherent in Kremer.

Claim 45: whereas, Kremer or Scroggie fails to teach selection of one or more notification mechanism based on cost of notification mechanism and customer's history of interacting with different mechanism, official notice is taken that selection of advertisement methods (news papers, direct mailing to selected consumers, electronic via the Internet, telemarketing etc.) are old and well known. It is expected that the merchants would monitor the response of different mechanisms of such advertisements

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(i.e. promoting products) so as to promote their products to selected consumers only through a most cost efficient mechanism.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kremer and Scroggie et al as applied to claim 1 above, and further in view of Day et al. (US Pat. 5,857,175).

Claim 9: Day et al. Teaches a method wherein selected merchandise items are promoted by posting a notice of discounts on a network accessible from the location selling the selected merchandise (kiosk 26 which houses "offer communicator" for communicating special offers to consumers, col. 4 L 59-64). It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to post the notice of discounts (offers) on a network accessible from the location selling the selected items as recited in Day et al. reference because it would provide convenience to the consumer to receive the discount offers adjacent to where the discounted items are sold, also the consumer are more likely to use the promotion offer when at the location where the items are being sold.

All other limitations of claim 9 are analyzed as in claim 1.

15. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kremer and Scroggie et al as applied to claim 1 above, and further in view of Csaszar et al. (US Pat. 5970124).

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Claims 10 : Kremer or Scroggie references fail to teach that the promoting step comprises posting a notice of the discount or special price for the selected item on a network accessible through audio device wherein acknowledgement of promoting step comprises walking past an audio device. The Csaszar patent, in the same field of endeavor, however, explicitly teaches these limitations (abstract, ...advertising messages that an interactive voice response system can deliver to a consumer...made responsive to telephone calls placed to an IVR system... abstract and col. 3 L 22-36, col. 3 L 63- col. 4 L 2, selected items are based on the consumer (student) identification). It would have been obvious to one of ordinary skill in the art to post a notice of a discount or special price of a selected item on a network accessible through an audio device as claimed because the information ( the notice..) would be delivered at any time and at low cost.

All other limitations of claims 10 are analyzed as in claim 1.

#### *Allowable Subject Matter*

16. Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

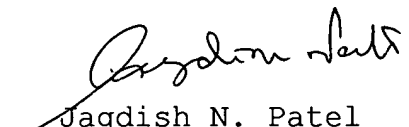
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup> Floor, Alexandria VA 22202.

A handwritten signature in cursive script, appearing to read "Jagdish N. Patel", is written over the printed name.

Jagdish N. Patel

(Examiner, AU 3624)

8/4/03